

REMARKS

Claims 1-8, 16, 19, 22, 24, 25, and 28 are pending in the application. Claims 1 and 3 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent Nos. 6,269,348, 5,870,723 and 5,838,812. Claims 1-8, 16, 19, 22, 24, 25 and 28 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-8, 16, 19, 22, 24, 25 and 28 stand rejected under 35 U.S.C. §102(e) as being anticipated by Merjanian '471. Claims 1-8, 16, 19, 22, 24, 25 and 28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Merjanian '471 in view of Laor. Claims 1-8, 16, 19, 22, 24, 25 and 28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Merjanian in view of Laor and further in view of Pu, et al. or Kuhns, et al.

Reconsideration is respectfully requested. The rejections are traversed. No new matter is added. Claims 1-2, 4, 6-7, 16, and 22 are amended. Claims 3, 5, 8, 19, 24, and 28 are canceled. Claimed 45-48 are added. Claims 1-2, 4, 6-7, 16, 22, and 45-48 remain in the case for consideration.

DOUBLE-PATENTING

In light of the amendments to the claims, the Applicant respectfully requests that the Examiner revisit whether the claims are still properly rejected as double-patented over U.S. Patent Nos. 6,269,348, 5,870,723 and 5,838,812.

REJECTIONS UNDER 35 U.S.C. §§ 102(e) AND 103(a)

Although the claims remaining in the patent application are different from the previous claims, the Applicant would like to discuss briefly some general points as to why the claims are patentable over Merjanian, whether or not Laor, Pu, and/or Kuhns are applicable.

Merjanian does not teach a scrip supporter, scrip donator, and scrip beneficiary, and food stamps are not equivalent to electronic scrip

Claim 1 mentions a scrip supporter, a scrip donator, and a scrip beneficiary. The scrip supporter provides the bid biometric sample, whereas the credit for the transaction is credited to an account of the scrip beneficiary. As defined in the specification, "[a] Scrip Supporter is any individual person who participates in a program to donate scrip to a non-profit entity

based upon his purchases, expenditures, or service usages" (see page 14, lines 12-14). The scrip donator is a party controlling the scrip donator account (see page 13, lines 26-28), which is the account debited as a result of the transaction. The scrip donator can be either the scrip supporter or the scrip merchant. Finally, the scrip beneficiary is the entity that receives donations (see page 14, lines 9-11).

In rejecting the previously-pending claims, the Examiner cited to the example of a user of food stamps as inherently using electronic scrip. The Applicant points out that using food stamps as described by Merjanian or the home page of the Virginia Department of Social Services does not appear to involve a scrip supporter, scrip donator, and scrip beneficiary as required under claim 1. For the same reason, the example of a person seeking benefits under programs such as welfare or Medicaid, as described in column 11 of Merjanian, fails to teach the features of the claimed invention.

The home page of the Virginia Department of Social Services is not a proper prior art reference

The Examiner turns to the home page of the Virginia Department of Social Services for support that food stamps are "electronic benefits". From this, the Examiner reasons that food stamps as recited in Merjanian could be electronic.

The Examiner is combining multiple references in rejecting the claims. Such a combination is inappropriate under 35 U.S.C. § 102(e), which directs that a single reference must anticipate the claimed invention.

The Examiner might have been arguing that the claims were properly anticipated, and the home page of the Virginia Department of Social Services was merely showing the inherency of food stamps as electronic scrip. The Applicant acknowledges that MPEP § 2124 does provide an exception to the rule that a critical reference must antedate the filing date of the patent application. But MPEP § 2124 is clear that this exception only exists as to "universal fact[s] . . . includ[ing] the characteristics and properties of a material or a scientific truism".

First, it is clear that MPEP § 2124 was designed to cover the situation where the reference describes something that does not change over time, but the description might be hard to find in a reference that antedates the patent. MPEP § 2124 was not designed to provide a teaching of anything that might be "inherent", regardless of the reference's publication date.

Second, the Applicant points out that the use of food stamps as electronic scrip, even if suggested by the home page of the Virginia Department of Social Services, is not a universal fact. Food stamps are items that can be provided by the government. Should the government choose to abolish the food stamp program, food stamps will no longer be available. Food stamps are not a "material" that has characteristics or properties, nor are food stamps "scientific truisms", as described in MPEP § 2124. Therefore, food stamps, and their "characteristics" or "properties", are not universal facts.

Third, up until recently in food stamp programs, food stamps were limited to paper coupons. Thus, the description by the home page of the Virginia Department of Social Services that food stamps can be implemented electronically is not a "universal fact": it was not true only a short time ago.

Even as a rejection under 35 U.S.C. § 103(a), the home page of the Virginia Department of Social Services is not available as prior art. The Examiner's printout has a date of November 10, 2005: this date is echoed on the page itself. While it might be true that the date shown in the body of the printout is merely a reflection of the date the Examiner visited the web site, the Examiner still bears the burden of establishing that the printout is proper prior art. Under MPEP § 2128, "[p]rior art disclosures on the Internet or on an on-line database are considered to be publicly available as of the date the item was publicly posted. If the publication does not include a publication date (or retrieval date), it cannot be relied upon as prior art under 35 U.S.C. 102(a) or (b) . . ." As the home page of the Virginia Department of Social Services does not provide a publication date, the home page cannot be used as prior art under 35 U.S.C. § 102, and therefore is also not available under 35 U.S.C. § 103.

Thus, the Examiner's citation to the home page of the Virginia Department of Social Services is inappropriate under either 35 U.S.C. §§ 102(e) or 103(a).

Merjanian does not teach or suggest a tokenless system

The Examiner argues that Merjanian teaches a tokenless system, and refers to column 10 of Merjanian as disclosing use in controlling food stamp distribution. The Applicant points out that at column 10, lines 19-22, where Merjanian discusses food stamps, actually teaches away from a tokenless system. Merjanian says that "[t]he card reader can be replaced by other data extracting means, such as a scanning wand, for extracting information from . . . food stamps". In other words, the food stamps have to be paper coupons or other physical objects that can be read by the "data extracting means", be that means a scanning wand, a

card reader, or the like. Because the food stamps have to be physical objects in Merjanian, and because they have to be presented at the point-of-sale to be read by the data extracting means, food stamps as intended by Merjanian are tokens. In contrast, the claimed invention is directed toward a tokenless method, namely where the transaction is performed without presenting tokens. Since Merjanian requires the presentation of a token, Merjanian cannot teach or suggest the claimed invention.

The Examiner also cited to column 11, lines 1-21 as teaching a tokenless operation. The Applicant notes that this section describes a user's enrollment with the system, and not a user's attempt to perform a transaction. As the Examiner has cited elsewhere, column 10 of Merjanian describes performing a transaction at a point of purchase terminal, where a token would or would not be presented. As discussed above, Merjanian teaches the presentation of a token. So this section of Merjanian also fails to teach or suggest the claimed invention.

The Examiner inappropriately refused to consider the negative limitation

Regarding the Examiner's comment that the phrase "without the scrip supporter presenting any smartcards or magnetic swipe cards" is a negative limitation, the Examiner is referred to MPEP § 2173.05(i). According to MPEP § 2173.05(i), claims are not inherently ambiguous or uncertain just because they include a negative limitation. And nowhere does the MPEP state that negative limitations are not to be given any weight. Furthermore, the opinion of the court in *In re Wakefield*, 422 F.2d 897, 899, 904, 164 U.S.P.Q. 636, 638, 641 (C.C.P.A. 1970) suggests otherwise. Accordingly, the Examiner's decision to assign no weight to the negative limitation is not supported by the MPEP.

Laor does not teach electronic scrip

In arguing that Merjanian and Laor, in combination, rendered the claimed invention obvious, the Examiner argued that Laor disclosed electronic coupons as a form of "script". The Applicant recognizes that Laor teaches "electronic coupons" and mentions "script" a number of times. But Laor's "script" always refers to scripts used by a web site. The first such use is in column 2, lines 58-60. Every other use of the term "script" by Laor appears in a similar context. Laor's "scripts" refer to code that can be executed by a computer, and has nothing to do with scrip as claimed.

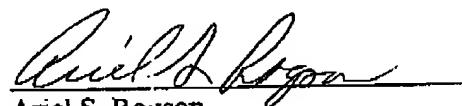
In contrast, as opposed to "script" that is code, on page 1, line 31, through page 2, line 3 of the patent application, "[s]crip is defined as any unit of data, such as currency, products or services, which is honored by a Scrip Merchant such that a Scrip Supporter's purchase,

expenditure or usage of these units results in the Scrip Supporter's donation of goods, services or currency to a pre-designated non-profit entity (Scrip Beneficiary)". Laor does not teach electronic "scrip", as the Examiner suggested, and therefore Laor fails to cure the deficiency the Examiner acknowledged existed in Merjanian.

For the foregoing reasons, reconsideration and allowance of claims 1-2, 4, 6-7, 16, 22, and 45-48 of the application as amended is solicited. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.



Ariel S. Rogson
Reg. No. 43,054

MARGER JOHNSON & McCOLLOM, P.C.
210 SW Morrison Street, Suite 400
Portland, OR 97204
503-222-3613
Customer No. 20575